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10/673,045

09/26/2003

Stephen J. Brown

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EXAMINER

HU, KANG

ART UNIT

PAPER NUMBER

3715

MAIL DATE

DELIVERY MODE

03/31/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/673,045 | Applicant(s) BROWN ET AL. | |
| | Examiner KANG HU | Art Unit 3715 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48,50-52,55-62,64,65,68-79,81-84 and 96-122 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48,50-52,55-62,64,65,68-79,81-84 and 96-122 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Present office action is in response to amendment filed on 11/23/2009, claims 1-47, 49, 53, 54, 63, 66, 67, 80, 85-95 were previously cancelled, claims 48, 50-52, 55-62, 64, 65, 68-79, 81-84 and 96-122 are currently pending in the application.

Terminal Disclaimer

1. Previously applicant's representative filed terminal disclaimer on 8/21/2007 to overcome the obviousness double patenting rejection made in non-final office action on 5/21/2007. The office action dated 9/1/2009 indicated that the terminal disclaimer has been reviewed and deemed improper. The examiner acknowledges the receipt of the certificate of amendment of articles of incorporation of Raya systems 11/23/2009, however a new disclaimer is needed to be filed on record. The double patenting rejection is maintained until a new terminal disclaimer is filed on record.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 48, 50-52, 59, 61, 75-79, and 81-84 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 5, 6, 11, 12, 14, 15, and 17 of U.S. Patent No. 5,601,435. Claims 48, 50, 51, 52, 59, 61, 75, 76, 77, 78, 79, 81, 82, 83, and 84 most closely relate to claims 1, 5, (1 and 5), 6, 3, (1 and 2), 11, 12, 14, 15, 17, 11, 12, 15, and 17, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly pending claims represent an obvious variation of the patented claims. With respect to claim 48 which correlates to patented claim 1, the claims commonly show the features of a multimedia processor to provide audio and visual signals, a physiological data monitor to provide physiological parameter of a user, a patient isolating circuit and a program controller to retrieve external information. The patented claim however

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does not recite a blood glucose monitor. However, a physiological data monitor is a generic term which includes the field of all blood glucose monitors for measuring glucose levels. On of ordinary skill in the art could not practice the more specific version presently claimed without infringing on the more generic version. The remaining claims 50-52, 59, 61, 75, 76, 77, 78-79, 81-84 recites similar limitations as those provided in the patent 5,601,435 and are identified above.

Priority

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application Nos. 08/247,716, 08/857,187, 08/958,786 fails to provide adequate support or enablement for an interface device coupled between the processor and the physiological data monitor to at least isolate electrically the physiological data monitor from the processor while coupled therebetween. The instant

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application is therefore only provided with the priority date of 11/4/1994, the filing date of application 08/334,643.

Claim Objections

5. Claims 96, 100, 104, 108, and 112 are objected to because of the following informalities: the claim should not contain quotation marks around limitations. Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 48, 50-52, 55-62, 64, 65, 68-79, 81-84 and 96-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (US 5,722,418) in view of Benton (US 4,926,325) and Jefferson (US 4,282,604).

Re claims 48, 51, 62, 75, 81 and 122, Bro teaches a blood glucose monitoring system for monitoring a blood glucose level and for providing health-related information comprising: a display device including a display screen which displays the blood glucose level as measured (col 17, lines 15-25),
an audio speaker (col 17, line 35)

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a processor configured to provide audio and visual signals to the audio speaker and the display device respectively (col 17, lines 15-25);

at least one built-in memory including read-only digital memory or writeable digital memory, having stored therein operation data and operation software routines (col 15, line 58-61);

software for controlling the blood glucose monitoring system (col 14, lines 35-40; col 38, lines 1-15);

comparing the blood glucose level as measured with stored measurements (col 14, lines 50-56);

performing one or more further processing functions in response to the comparing (col 14, lines 60-67, program including many motivational and reinforcement messages);

connecting to a remotely located computer (col 14, lines 42-55, patient database), Bro does not teach of providing an address of the remotely located computer from a removable memory card.

Bro teaches of automatically dials the telephone number associated with the operating system (address) (col 18, lines 50-52). Benton teaches of providing a portable module with containing identification and account information (Benton, col 3, lines 5-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Benton to Bro to provide a portable memory device containing the address of the remotely located computer for convenience.

Bro further teach receiving the health-related information from the remotely located computer (col 9, lines 55-61, questions regarding health);

at least one physiological data monitor configured to provide a measurement signal representative of a physiological parameter of a user and reside outside a first housing containing said processor (col 14, lines 35-41, EEG or blood sugar, blood pressure, heart monitor etc.);

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Bro teaches of an interface device coupled between the processor and the physiological data monitor (interactive television, or computer), however Bro does not teach of the interface device used to provide electrical isolation. Jefferson provides teaching of an optical isolation circuit for electrical isolation (Jefferson, col 3, lines 54-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Bro by Jefferson by providing an electrical isolation circuit in order to provide high state of stability between the processor and the physiological data monitor.

Bro further does not explicitly teach of providing the electrically isolating interface device not disposed within said first housing containing said processor nor any housing containing said physiological data monitor. However it would have been an obvious matter of design choice for the placement of isolating interface device to be located separately from the processor and the physiological data monitor as the applicant has not disclosed that the placement provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have easily modified the system to place the interface device disposed outside of the housing for processor and physiological data monitor. Therefore, it would have been prima facie obvious to modify Bro to rearrange different parts to place the interface device disposed outside of the housing for processor and physiological data monitor because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Bro in view of Jefferson.

Bro further teaches of an input device in communication with the processor and configured to receive an input from the user; enable the user to make selections and control one or more user functions of the blood glucose monitoring system (signal received from monitoring devices); and

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provide a control signal to the processor based upon the input, thereby to cause the health related information to be provided to the user based upon the measurement signal representative of the blood glucose level and the control signal (col 9, lines 20-30; col 13, lines 15-39, interactive, telecommunication and or multi-video transmission); and col 17, line 65- col 18, line 7), wherein the physiological parameter includes the blood glucose level and the physiological data monitor includes a blood glucose indicator; and a cable coupling the interface device to the processor (col 18, lines 65-67, other device such as glucose monitoring, blood pressure, heart rate etc.; connection between the interface device and processor).

Re claims 50, 64, 79 and 84, a signal receiver for receiving the measurement signal representative of the blood glucose level from at least one physiological data monitor (Bro, col 20, lines 5-10, interactive television or computer); converter for converting the measurement signal as received into a form acceptable to the processor (Jefferson,, col 3, lines 54-67, explained in claim 1), and a processor controller for controlling the processor (Bro, col 11, lines 20-50, inputs).

Re claims 52 and 65, the interface device utilizes optical isolation (Jefferson, col 3, lines 54-67).

Re claims 55 and 68, the input device is hand-held (Bro, col 57, line 35, hand-held personal communicator).

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Re claims 56 and 69, the input device received the input from the user through at least one push button switch (Bro, col 33, line 53).

Re claims 57, 70, 98, 102, 106, 110, 114, the health related information provided from the remotely located computer to the user includes moving images displayed on the display screen (interactive video).

Re claims 58 and 71, the health related information provided from the remotely located computer to the user further includes a comparison of measurements of the blood glucose level with previously stored measurement of the blood glucose level (Bro, col 11, lines 20-53, intended use of the system to monitor patient's health; col 14, lines 35-40, blood sugar monitor; col 23, line 48-63, custom tailor reinforcement for compliance to the patient's response profile).

Re claims 59 and 72, the health related information provided from the remotely located to the user includes educational information (Bro, col 58, line 18).

Re claims 60 and 73, blood glucose monitoring system is configured to store particular information on at least one built-in memory for later retrieval (saving on the interactive computer or television system).

Re claims 61, 74 and 77, the display device is a television (Bro, col 20, line 7).

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Re claims 76 and 82, the processor comprises a video game console (applicant admitted prior art, office action 9/1/2009) It would have been obvious to one of ordinary skill in the art at the time of the invention to use a game console as the processor to provide more entertainment.

Re claims 78, 83, 97, 101, 105, 109 and 113, CD-ROM drive, and interchangeable compact disk removably coupled to the CD-ROM drive for providing additional functionality to the processor (Bro, col 14, lines 45-55; col 15, line 60).

Re claims 96, 100, 104, 108 and 112, one or more communication ports configured to connect the blood glucose monitoring system to an information superhighway (Bro, col 18, lines 44-67, glucose monitor connected to a network).

Re claims 99, 103, 107, 111, 115 and 116, built-in memory has stored therein alarm data and alarm software routines for triggering an alarm if the blood glucose level as measure falls outside a predetermined range (Bro, col 55, line 30-40, reminder regarding compliance).

Re claims 117 and 118, operational data and the operational software routines are configured to store particular information to support later retrieval or download based on the comparing (Bro, col 32, lines 35-40, record messages for later retrieval).

Re claim 119, operational data and the operation software routines are configured to ask questions of the user based on the comparing (Bro, col 57, lines 55-60).

Re claim 120, give advice as to diet or exercise habits (Bro, col 11, lines 20-50).

Re claim 121, wireless input device (Bro, col 20, lines 20-21, wireless transmission)

Response to Arguments

Examiner has previously taken official notice (office action 9/1/2009) of game boy having audio speakers is old and well-known to one of ordinary skill in the art, when official notice goes unchallenged it becomes admitted prior art. See MPEP 2144.03, section C.

8. Applicant's arguments with respect to claims 48, 50-52, 55-62, 64, 65, 68-79, 81-84 and 96-122 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KANG HU whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-262-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

/K. H./
Examiner, Art Unit 3715